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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,312	06/04/2001	Mark Eyer	50N3465.01	7049
26338	7590	04/20/2005	EXAMINER	
MERLE W. RICHMAN, III P.O. BOX 3333 LA JOLLA, CA 92038			SHANNON, MICHAEL R	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,312

Applicant(s)

EYER, MARK

Examiner

Michael R Shannon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-124 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 36, 59, 60, 94, and 118 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020117.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 36 is objected to because of the following informalities: Claim 36 cites "at least one remote unit of claim 15", which is an apparent typographical error and should be corrected to read "at least one remote unit of claim 35", as is assumed in the following art rejection. Appropriate correction is required.
2. Claim 118 is objected to because of the following informalities: Claim 118 cites "the system of claim 106", which is an apparent typographical error and should be correction to read "the system of claim 116", as is assumed in the following art rejection. Appropriate correction is required.
3. Claims 23, 24, 59, 60, and 94 are objected to because there is insufficient antecedent basis for this limitation "the service module" in the claim. It will be assumed to read "the security module" for purposes of the art rejection below.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1, 2, 24, 25, 35-38, 60, 61, 71, 72, 94, 95, 105, 106, 115, and 116 are rejected under 35 U.S.C. 102(e) as being anticipated by Alonso et al (USP 6,184,878), cited by examiner.

Regarding claim 1, the claimed "method for a plurality of multimedia units linked to a multimedia service provider and an Internet via the multimedia service provider to communicate with the service provider" is met as follows:

- The claimed step of "each of the plurality of multimedia units receiving an Internet Protocol ("IP") address for the multimedia service provider" is met by column 2, lines 1-11, wherein Alonso discloses a connection to a server via an IP protocol. Each of the plurality of multimedia units 40-1 ... 40-n is connected to the multimedia service provider 30 by Forward Channel and Back Channel and communication via Internet Protocol.
- The claimed step of "each of the plurality of multimedia units communicating with the multimedia service provider via the IP address" is met, again, by column 2, lines 1-11, wherein Alonso discloses a connection to a server via an IP protocol. Each of the plurality of multimedia units 40-1 ... 40-n is connected to the multimedia service provider 30 by Forward Channel and Back Channel and communication via Internet Protocol.

Regarding claim 2, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

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Regarding claim 24, the claimed "each of the plurality of multimedia units includes a security module" is met by the inherent ability for the STT 42 to know the IP address to contact for communicating with the multimedia service provider. The claimed steps of "designating an IP address for the multimedia service provider on the service module and each of the plurality of multimedia units retrieving the IP address from the service module" are met by the same inherent ability for the STT 42 to know the IP address to contact for communicating with the multimedia service provider.

Regarding claim 25, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 35, the above rejection to claim 1 can be taken accordingly.

Regarding claim 36, the claimed "units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 37, the above rejection to claim 1 can be taken accordingly.

Regarding claim 38, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 60, the above rejection to claim 24 can be taken accordingly.

Regarding claim 61, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 71, the above rejection to claim 1 can be taken accordingly.

Regarding claim 72, the claimed "multimedia unit is a set top box" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 94, the above rejection to claim 24 can be taken accordingly.

Regarding claim 95, the claimed "multimedia unit is a set top box" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 105, the above rejection to claim 1 can be taken accordingly.

Regarding claim 106, the claimed "multimedia unit is a set top box" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 115, the claimed "system for communicating multimedia service provider information in a multimedia service provider network" is met as follows:

- The claimed "multimedia service provider coupled to the network comprising means for generating a Web page of the information and means for communicating the Web page via the network" is met by the head end 30 coupled to the network discussed in claim 1 [col. 3, lines 10-13], which can retrieve and communicate Web pages to the set top terminals that are coupled to the network [col. 4, lines 48-56].
- The claimed "multimedia unit coupled to the network, the unit comprising means for communicating with the Web page via the network" is met by the interaction with the Web page as discussed in column 4, lines 48-56 and column 2, lines 1-11.

Regarding claim 116, the claimed "multimedia unit is a set top box" is met by the fact that the multimedia receiving units are set top terminals 42.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12-13, 23, 48-49, 59, 82-83, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alonso et al (USP 6,184,878), cited by examiner.

Regarding claim 12, the Alonso reference teaches all of that which is discussed above with regards to claim 1, yet is silent as to the specific steps to carry out step (a), as claimed. The Alonso reference, consequently does not teach the steps of "designating a uniform resource locator (URL) for the multimedia service provider; each of the plurality of multimedia units receiving the URL; and resolving the URL into an IP address for the multimedia service provider". The Alonso reference simply discloses the use of the Internet Protocol in communicating with the head-end and receiving and contacting an IP address assigned to the head-end [col. 2, lines 1-11]. The Examiner takes Official Notice that it is notoriously well known in the art to provide URL's instead of IP addresses to users. URL's are then resolved into IP addresses in order to link to a server or head-end assigned to that IP address. It therefore would have been obvious to one of ordinary skill in the art at the time of the invention to utilize URLs in an Internet Protocol system, in order to make the communication more understandable and more easily linkable (since URLs are much more memorably than IP addresses).

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Regarding claim 13, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 23, the above rejection to claim 12 can be taken accordingly.

Regarding claim 48, the above rejection to claim 12 can be taken accordingly.

Regarding claim 49, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 59, the above rejection to claim 12 can be taken accordingly.

Regarding claim 82, the above rejection to claim 12 can be taken accordingly.

Regarding claim 83, the claimed "multimedia units are set top boxes" is met by the fact that the multimedia receiving units are set top terminals 42.

Regarding claim 93, the above rejection to claim 12 can be taken accordingly.

8. Claims 3-11, 14-22, 26-34, 39-47, 50-58, 62-70, 73-81, 84-92, 96-104, 107-114, and 117-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alonso et al (USP 6,184,878), cited by examiner, in view of Lemmons et al (USP 6,442,755), cited by examiner.

Regarding claim 3, the Alonso reference teaches all of that which is discussed above with regards to claim 1. The Alonso reference does not, however, teach that the "communication with the service provider includes information about the services available from the multimedia service provider". The Lemmons reference discloses an EPG in markup language form (such as HTML) that can be used at the set top box to select programs and services that the server offers [col. 3, lines 20-31]. It would have

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been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

Regarding claim 4, the Alonso and Lemmons references teach all of that which is discussed above with regards to claim 3. The Alonso reference does not, however, teach that the "multimedia service provider generates a Web page at the IP address that includes information about the services available from the multimedia service provider". The Lemmons reference discloses an EPG in markup language form (such as HTML) that can be used at the set top box to select programs and services that the server offers [col. 3, lines 20-31]. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

Regarding claim 5, the above rejection to claim 3 can be taken accordingly.

Regarding claim 6, the above rejection to claim 4 can be taken accordingly.

Regarding claim 7, the Alonso reference teaches all of that which is discussed above with regards to claim 1. The Alonso reference does not, however, teach that the "communication with the service provider enables each of the plurality of multimedia units to access services of the multimedia service provider". The Lemmons reference discloses an EPG in markup language form (such as HTML) that can be used at the set

top box to select programs and services that the server offers [col. 3, lines 20-31]. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

Regarding claim 8, the Alonso reference teaches all of that which is discussed above with regards to claim 7. The Alonso reference does not, however, teach that the "multimedia service provider generates a Web page at the IP address that includes links to enable each of the plurality of multimedia units to access services of the multimedia service provider". The Lemmons reference discloses an EPG in markup language form (such as HTML) that can be used at the set top box to select programs and services that the server offers [col. 3, lines 20-31]. As can be seen in Figures 4 and 5, the Lemmons reference teaches links (such as 171) to multimedia content on the server. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

Regarding claim 9, the Alonso reference teaches all of that which is discussed above with regards to claim 7. The Alonso reference does not, however, teach that the "communication with the service provider enables each of the plurality of multimedia units to select multimedia programs available from the multimedia service provider". The Lemmons reference discloses an EPG in markup language form (such as HTML)

that can be used at the set top box to select programs and services that the server offers [col. 3, lines 20-31]. As can be seen in Figures 4 and 5, the Lemmons reference teaches links (such as 171) to multimedia content on the server. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

Regarding claim 10, the Alonso reference further discloses that the system can contain VOD service [36 of Figure 1].

Regarding claim 11, the Alonso and Lemmons references teach all of that which is discussed above with regards to claim 8. The Alonso reference does not, however, teach, "services of the multimedia service provider include an Electronic Program guide". The Lemmons reference discloses an EPG in markup language form (such as HTML) that can be used at the set top box to select programs and services that the server offers [col. 3, lines 20-31]. As can be seen in Figures 4 and 5, the Lemmons reference teaches links (such as 171) to multimedia content on the server. It would have been obvious to one of ordinary skill in the art at the time of the invention to allow the web pages to display information about services available from the service provider, in order to allow a standard format (such as a web-site in HTML language) to provide layout information that is customizable and not Operating System specific.

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Regarding claims 14-22, the above rejections to claims 3-11 can be taken accordingly while taking into consideration the Official Notice taken by the Examiner in the rejection of claim 12.

Regarding claims 26-34, the above rejections to claims 3-11 can be taken accordingly.

Regarding claims 39-47, the above rejections to claims 3-11 can be taken accordingly.

Regarding claims 50-58, the above rejections to claims 3-11 can be taken accordingly while taking into consideration the Official Notice taken by the Examiner in the rejection of claim 48.

Regarding claims 62-70, the above rejections to claims 3-11 can be taken accordingly.

Regarding claims 73-81, the above rejections to claims 3-11 can be taken accordingly.

Regarding claims 84-92, the above rejections to claims 3-11 can be taken accordingly while taking into consideration the Official Notice taken by the Examiner in the rejection of claim 82.

Regarding claims 96-104, the above rejections to claims 3-11 can be taken accordingly.

Regarding claims 107-110, the above rejections to claims 3-6 can be taken accordingly.

Regarding claim 111, the above rejection to claim 8 can be taken accordingly.

Regarding claims 112 and 113, the above rejection to claims 10 and 11 can be taken accordingly.

Regarding claim 114, the claimed "security module, wherein the security module includes the IP address of the multimedia provider" is met by the inherent ability for the STT 42 to know the IP address to contact for communicating with the multimedia service provider.

Regarding claim 117, the above rejection to claim 4 can be taken accordingly.

Regarding claim 118, the Alonso reference further teaches the IP protocol being used throughout the system [col. 2, lines 1-11] and the set top terminals, which can retrieve and communicate Web pages to the set top terminals that are coupled to the network [col. 4, lines 48-56]. This meets the claimed "first means comprising means for communicating the Web page via the IP address and the second means comprising means for communicating the Web page via the IP address".

Regarding claim 119, the above rejection to claim 4 can be taken accordingly.

Regarding claim 120, the above rejection to claim 8 can be taken accordingly.

Regarding claim 121, the above rejection to claim 8 can be taken accordingly.

Regarding claim 122-123, the above rejections to claims 10-11 can be taken accordingly.

Regarding claim 124, the claimed "security module, wherein the security module includes the IP address of the multimedia provider" is met by the inherent ability for the STT 42 to know the IP address to contact for communicating with the multimedia service provider.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fries (USP 6,317,885) discloses a system for interaction at the STB using interactive pages (see Figure 6).

Gardell et al (USP 6,049,831) discloses a way of viewing web sites at a receiver using a re-composition of definitions and page information.

Weinstein et al (USP 6,604,242) discloses a system for combining Internet web sites and TV broadcasts.

Zigmond et al (USP 6,785,902) discloses another system for combining Internet sites and broadcast TV.

Boyer et al (USP 6,268,849) discloses an online EPG with real-time content for currently broadcast TV shows.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon whose telephone number is (571) 272-7356. The examiner can normally be reached Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
April 15, 2005



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600